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10/816,975	04/02/2004	Narasimhan Sundararajan	MS#305305.01 (5228)	1693

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EXAMINER

SAN JUAN, MARTINJERIKO P

ART UNIT	PAPER NUMBER
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2432

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/816,975	Applicant(s) SUNDARARAJAN, NARASIMHAN	
	Examiner MARTIN JERIKO P. SAN JUAN	Art Unit 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-13 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a response to Applicant's Amendments filed on October 23, 2008.

Claims 1-5, 8-13, and 16-20 are currently pending.

Response to Arguments

1. Applicant's arguments, see Remarks and Amendments, filed October 23, 2008, with respect to the rejection(s) of claim(s) 1-5, 8-13, and 16-20 under Wray have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Pabla, Young, and Dierks as presented in the prior art rejection.

Claim Objections

1. Claim 9 is objected to because of the following informalities:

Claim 9 ... receiving ~~confirmation~~ confirmation ...

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims fail to place the invention squarely within one statutory class of invention. At Par 0025 of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s)

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is/are not statutory. Energy is not a series of steps or acts and thus is not a process.

Energy is not a physical article or object and as such is not a machine or manufacture.

Energy is not a combination of substances and therefore not a composition of matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 9, the limitation "receiving conformation [confirmation] from the first client for verifying the copy of the first UID is identical to the first UID at the first client" is not supported in the specification." Nowhere in the specification shows that the second client has received anything about the successful verification of the first UID, other than the third email message being sent upon successful verification. For purposes of examination, sending the third email message is also a confirmation of verifying the copy of the first UID is identical to the first UID at the first client.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness

under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-4, 8-12, 16-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pabla [US 7127613 B2], and further in view of Young [US 7024690 B1].

Regarding claim 1 Pabla teaches a method for authenticating a sender of a digital object, comprising:

recognizing a peer-to-peer (P2P) communication between a first client and a second client, said first client attempting to exchange information securely with said second client via the P2P communication without a third party mediation, said third party

mediation including certificate authorities [Pabla 2: 31-46] [Pabla 5: 30-46];

establishing an electronic mail protocol between the first client and the second client,

said e-mail protocol, being separate from the P2P communication, comprising Simple Mail Transport Protocol (SMTP) [Pabla 21: 23-29 --MIME content type uses SMTP.];

generating a first unique identifier (UID) [Pabla 20: 20];

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transmitting from the first client to a previously known address of the second client, via the established electronic mail protocol, a first electronic mail (e-mail) message comprising the first UID [Pabla 5: 55-59]; receiving from the second client, via the electronic mail protocol, a second e-mail message directed to the first client comprising a second UID [Pabla 5: 61-64];

wherein at least one of the e-mail messages transmitted to the previously known address between the first client and the second client further comprises the digital object [Pabla 5: 61-64], said digital object being used for authenticating the information to be exchanged between the first client and the second client via the P2P communication and not for authenticating the first e-mail message, the second e-mail message, or the third e-mail message [MPEP 2106 --Statements of intended use does not limit a claim to a particular structure, and therefore does not limit the scope of a claim or claim limitation.].

Pabla does not explicitly teach authenticating the user comprising transmitting from the first client to a previously known address of the second client, the first message comprising the first UID; receiving from the second client, the second message directed to the first client comprising a second UID and a copy of the first UID; verifying the copy of the first UID is identical to the first UID at the first client; and transmitting from the first client to the previously known address of the second client, via the electronic mail protocol, a third e-mail message to the second client comprising a copy of the second UID.

Young teaches authenticating a user comprising the method of generating a first unique

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identifier (UID) [Young 5: 46]; transmitting from the first client to a previously known address of the second client, via an established protocol, a first message comprising a first UID [Young 5: 45-49]; receiving from the second client, via the established protocol, a second message directed to the first client comprising a second UID and a copy of the first UID [Young 6: 5-8 --message authentication code contains copy of the first UID]; verifying the copy of the first UID is identical to the first UID at the first client [Young 6: 15-21]; and transmitting from the first client to the previously known address of the second client, via the established protocol, a third message to the second client comprising a copy of the second UID [Young 6: 30-32 --the other message authentication code contains the copy of the second UID.].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Pabla's exchange of network service email messages by incorporating the established authentication protocol as taught by Young. The suggestion/motivation would have been to authenticate the service request e-mail messages prior to accepting any active content or digital objects that have been exchanged.

Regarding claim 2, Pabla in view of Young teaches the method of claim 1 wherein the first message further comprises the digital object [Pabla 5: 61-64].

Regarding claim 3, Pabla in view of Young teaches the method of claim 1 wherein the third message further comprises the digital object [Pabla 5: 61-64].

Regarding claim 4, Pabla in view of Young teaches the method of claim 1 wherein the digital object is a public key for a cryptographic system [Pabla 5: 61-64].

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Regarding claim 8, Pabla in view of Young teaches the method of claim 1 wherein the first UID contains at least 128 bits [Pabla Fig 12].

Regarding claim 9, Pabla teaches a method for authenticating a sender of a digital object, comprising:

recognizing a peer-to-peer (P2P) communication between a first client and a second client, said first client attempting to exchange information securely with said second client via the P2P communication without a third party mediation, said third party mediation including certificate authorities [Pabla 2: 31-46] [Pabla 5: 30-46];

establishing an electronic mail protocol between the first client and the second client, said e-mail protocol, being separate from the P2P communication, comprising Simple Mail Transport Protocol (SMTP) [Pabla 21: 23-29 --MIME content type uses SMTP.];

receiving from the first client to a previously known address of the second client, via the established electronic mail protocol, a first electronic mail (e-mail) message comprising a first UID [Pabla 5: 55-59]; generating a second UID at the second client [Pabla 20: 20]; transmitting from the second client, via the electronic mail protocol, a second e-mail message directed to the first client comprising a second UID [Pabla 5: 61-64];

wherein at least one of the e-mail messages transmitted to the previously known address between the first client and the second client further comprises the digital object [Pabla 5: 61-64], said digital object being used for authenticating the information to be exchanged between the first client and the second client via the P2P communication and not for authenticating the first e-mail message, the second e-mail message, or the third e-mail message [MPEP 2106 --Statements of intended use does

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not limit a claim to a particular structure, and therefore does not limit the scope of a claim or claim limitation.].

Pabla does not explicitly teach authenticating the user comprising receiving from the first client to a previously known address of the second client, the first message comprising a first UID; transmitting from the second client, the second message directed to the first client comprising the second UID and a copy of the first UID; receiving conformation from the first client for verifying the copy of the first UID is identical to the first UID at the first client; and receiving at the second client, via the electronic mail protocol, a third e-mail message comprising a copy of the second UID.

Young teaches authenticating a user comprising the method of receiving from the first client to a previously known address of the second client, via an established protocol, a first message comprising a first UID [Young 5: 45-49]; transmitting from the second client, via the established protocol, a second message directed to the first client comprising a second UID and a copy of the first UID [Young 6: 5-8 --message authentication code contains copy of the first UID]; receiving conformation from the first client for verifying the copy of the first UID is identical to the first UID at the first client [Young 6: 15-21]; and receiving at the second client, via the established protocol, a third message to the second client comprising a copy of the second UID [Young 6: 30-32 --the other message authentication code contains the copy of the second UID.].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Pabla's exchange of network service email messages by incorporating the established authentication protocol as taught by Young. The suggestion/motivation

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would have been to authenticate the service request e-mail messages prior to accepting any active content or digital objects that have been exchanged.

Claims 10-12, and 16 are rejected because these are similar matter to claims 2-4, and 8.

Claims 17, and 20 are rejected because these are similar matter to claim 1.

Claims 18 is rejected because it is similar matter to claim 4.

2. Claims 5, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pabla [US 7127613 B2], and further in view of Young [US 7024690 B1], Dierks [Dierks 1999].

Regarding claim 5, Pabla in view of Young teaches the method of claim 4 wherein the TLS is used for generating session keys [Pabla 7: 25-26].

Pabla in view of Young does not explicitly teach the second message further comprising a second public key for the cryptographic system.

Dierks teaches generating session keys using TLS comprising a second message in a handshake include a second public key for the cryptographic system [Dierks Page 30, Fig 1].

It would have been obvious to one of ordinary skilled in the art at the time of invention to modify Pabla in view of Young to include a second public key in the second message of a handshake as taught by Dierks. The suggestion/motivation would have been to follow the TLS protocol as part of generating session keys that require both party's public keys [Pabla 7: 25-26].

Claims 13 and 19 are rejected because these are similar matter to claim 5.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARTIN JERIKO P. SAN JUAN whose telephone number is (571)272-7875. The examiner can normally be reached on M-F 8:30a - 6:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MJSJ/

Martin Jeriko San Juan

Examiner, Art Unit 2432

/Benjamin E Lanier/

Primary Examiner, Art Unit 2432